


DEC 18 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 101.0092-02000	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/669,287	Filed September 24, 2003
		First Named Inventor Gary Karlin Michelson	
		Art Unit 3738	Examiner Thomas Barrett
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>34,383</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature Thomas H. Martin Typed or printed name 330-877-0700 Telephone number December 18, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**RECEIVED
CENTRAL FAX CENTER****DEC 18 2006****RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3764****PATENT
Attorney Docket No. 101.0092-02000
Customer No. 22882****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:)	Confirmation No.: 6591
Gary Karlin Michelson)	
Serial No.: 10/669,287)	Group Art Unit: 3738
Filed: September 24, 2003)	Examiner: Thomas Barrett
For: EXPANDABLE PUSH-IN ARCUATE)	
INTERBODY SPINAL FUSION)	
IMPLANT WITH TAPERED)	
CONFIGURATION DURING)	
INSERTION)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Final Office Action of June 16, 2006, Applicant submits the following remarks for consideration by the Members of the pre-appeal brief conference.

I. Brief Background

The application includes one independent claim, claim 1, generally drawn to a push-in interbody spinal fusion implant. Independent claim 1 stands rejected under 35 U.S.C. §§ 112, first paragraph, and 103(a). In response to the Final Office Action mailed June 16, 2006, Applicant submitted a Reply traversing the Examiner's rejections of claim 1 under 35 U.S.C. §§ 112, first paragraph, and 103(a). The rejections of claim 1 under 35 U.S.C. §§ 112, first paragraph, and 103(a) are the subject of this Request for a Pre-Appeal Conference.

Pre-appeal Brief Request 12-18-06.doc

Application No. 10/669,287
Pre-Appeal Brief Request For Review dated December 18, 2006
Reply to Final Office Action of June 16, 2006

II. Clear Errors

(1) The Examiner's rejection of claim 1 under 35 U.S.C. § 112, first paragraph, is erroneous because:

(a) in the Reply, Applicant submitted examples in the specification and figures supporting at least one embodiment of the push-in interbody spinal fusion implant of the present invention having an upper member having a portion being at least in part arcuate and a lower member having a portion being at least in part arcuate where "said arcuate portions of said upper and lower members in the first position being angled to one another over a majority of the longitudinal length of said implant and forming at least a portion of one of a frusto-conical shape and the shape of a cylinder split along a horizontal plane through its mid-longitudinal axis" as recited in independent claim 1.

(2) The Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,117,174 to Nolan ("Nolan") in view of U.S. Patent No. 5,785,710 to Michelson ("Michelson '710") is erroneous because:

(a) Nolan teaches an implant 10 that in an unexpanded position has surfaces that are parallel to each other along a majority of the length of the implant;

(b) Nolan does not teach or suggest an implant with upper and lower members having an arcuate portion, "said arcuate portions of said upper and lower members in the first position being angled to one another over a majority of the longitudinal length of said implant" as recited in independent claim 1; and

(c) neither Nolan nor Michelson '710, whether alone or in combination, teach or suggest an implant with upper and lower members having an arcuate portion, "said arcuate portions of said upper and lower members in the first position being angled to one another over a majority of the longitudinal length of said implant" as recited in independent claim 1.

III. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Therefore, it is requested that the Members of the Pre-Appeal Brief

Application No. 10/669,287
Pre-Appeal Brief Request For Review dated December 18, 2006
Reply to Final Office Action of June 16, 2006

Conference reconsider the outstanding rejections in view of the preceding comments.
Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: December 18, 2006

By: Thomas H. Martin
Thomas H. Martin
Registration No. 34,383

1557 Lake O'Pines Street, NE
Hartville, Ohio 44632
Telephone: (330) 877-0700
Facsimile: (330) 877-2030